REMARKS

Claims 1-49 are currently pending in the subject application and are presently under consideration. A current listing of the claims is shown at pp. 2-11 of the Reply.

Applicants' representative thanks the Examiner for the courtesies extended during the Interview conducted on July 24, 2007, during which the cited references and the pending claims were discussed. No agreement was reached. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   **Rejection of Claims 1, 2, 5-7, 9-11, 41, 42 and 45-48 Under 35 U.S.C. §102(e)**

Claims 1, 2, 5-7, 9-11, 41, 42 and 45-48 stand rejected under 35 U.S.C. §102(e) as being anticipated by Lee (6,611,814). This rejection should be withdrawn for the following reasons. Lee does not disclose or suggest each and every limitation set forth in the subject claims.

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

Applicants' claimed invention relates generally to creating an electronic shopping list (*e.g.*, a list of references to items) for a user and utilizing this list to purchase items for the user over the Internet. In particular, Independent claim 1 recites a system that facilitates electronic shopping through an electronic item list for items residing on the Internet comprising: *an item database holding information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type; an item list database that stores an item list that includes a reference to at least one item associated with the information stored in the item database; and an interface component that receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list, utilizes the reference as a key into the item database, retrieves data corresponding to the referenced item from the item database, and utilizes the retrieved data to*

display the item and associated information to the requester. Independent claims 41 and 47 recite similar features. Lee fails to disclose or suggest each and every element of the claimed subject matter.

Lee discloses a system and a method for generating virtual wish lists for assisting shopping over computer networks. Lee discloses a system that provides for virtual wish lists while not requiring the users to register to online stores for using the wish list service, and not *requiring the requiring the users to add products to buy to their wish lists.* (*See*, column 2, lines 59-64). Lee further discloses that "a virtual wish list 900 is automatically created, and it keeps information of product its owner is interested in by using the information collected from Web pages the person request and examines in the Internet". (*See* column 6, lines 24-30). On the other hand, the claimed subject matter relates to a system and a method that provides for a user interface that enables a user to create a personalized list of references to items (*e.g.*, offers, product categories, products from merchants, products from manufacturers…) by electronically selecting and adding such items to their item list. This list of references, as well as other users' item lists, is stored within an item list database. (*See* Specification, page 2, lines 11-18). To this end, independent claim 1 in part recites *an item database holding information with respect to items.* Furthermore, information related to items (*e.g.*, offer, manufacturer and merchant information) is stored within one or more item databases. (*See* Specification, page 6, lines 7-17). In general, an owner of an item list or a customer who intends on purchasing an item for owner of the item list can request the stored item list. On request, an interface component utilizes item references from the stored item list to extract related item data from the item databases. The extracted data is employed to present a list of items to a requester ensuring that *current item information* from the item databases is provided. (*See* Specification, page 7, lines 5-10). Lee fails to disclose or suggest such a process.

In particular, Lee fails to disclose or suggest **an interface component that receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list, utilizes the reference as a key into the item database, retrieves data corresponding to the referenced item from the item database, and utilizes the retrieved data to display the item and associated information to the requester.** In the Final Office Action (dated June 21, 2007), the Examiner argues that Lee discloses "an interface component … (Fig. 2)", and states that Lee "utilizes the reference … (Fig. 12)". Applicants'

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representative respectfully disagrees. At the indicated figure (Fig.2) and the associated passages, Lee discloses a flow chart and the various steps performed for using virtual wish lists for assisting shopping over computer networks. Lee discloses that when an online store 120 receives a virtual wish list 900, it prepares a list of product recommendations 1200 for recipients. (*See*, column 8, lines 8-10). Lee discloses that a product list generator 122 creates a product list 1200 using shopping list 1100 as the input. (*See*, column 13, lines 33-35). Lee further discloses that "sometimes it is possible that certain products in the shopping list (which uses the information from virtual wish list) are not available in the store 120 where the shopping list 1100 is submitted. Then the store 120 may not be able to have entries for such products the recommended product list 1200". (*See* column 13, lines 41-46). On the other hand, the claimed subject matter clearly teaches that by ***utilizing reference to items*** to extract items from the item database, the system ensures that the ***displayed item information is current.*** For example, if the price of an item is increased in an item database, the increased price will be automatically retrieved from the information database when item lists are displayed to. Similarly if a particular item is not available, the information is automatically retrieved from the information database without requiring a separate update of effected item lists. Lee is completely silent about such a process. Therefore, it is readily apparent that Lee fails to disclose or suggest each and every element of the claimed subject matter. For at least the above reasons, the rejection of independent claim 1, 41 and 47 (and claims 2, 5-7, 9-11, 42, 45-46, and 48 that depend there from) should be withdrawn.

II.   Rejection of Claims 3, 4, 43 and 49 Under 35 U.S.C. §103(a)

Claims 3, 4, 43 and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Hsu (7,013,292). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Lee and Hsu, individually or in combination, do not teach or suggest each and every element set forth in the subject claim.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable

expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*** *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Hsu does not make up for the aforementioned deficiencies of Lee with respect to independent claims 1, 41 and 49 (which claims 3, 4, 43, and 49 depend there from). Therefore, the claimed invention as recited in claims 3, 4, 43, and 49 is not obvious over the combination of Lee and Hsu. Thus, it is respectfully submitted that this rejection be withdrawn.

III.   Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of NetGift (a collection of articles and web pages). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Lee and NetGift, individually or in combination, do not teach or suggest each and every element set forth in the subject claim. In particular NetGift does not make up for the aforementioned deficiencies of Lee with respect to independent claims 1 (which claim 6 depends there from). Therefore, the claimed invention as recited in claims 6 is not obvious over the combination of Lee and NetGift. Thus, it is respectfully submitted that this rejection be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP151US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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